

REMARKS

This amendment is in response to the office action dated November 18, 2004. In the office action, claims 1-51 were rejected. Claims 1, 5, 11, 13, 21, 27-28, 34, 39-40, 46-47 and 49 are amended. Claims 3, 10-11 and 28 are canceled. In addition, new claims 52-54 have been added. A detailed discussion of each item in the office action follows.

INFORMALITIES

In addition to the items raised by the Examiner in the office action, some minor typographical and/or 35 U.S.C. 112 errors were corrected in claims 5, 10-11, 13, 39, 46 and 49. The nature of the amendments will be self-evident when examining the claims.

ABSTRACT

In item 2 of the office action, the abstract was objected to. Applicants' Attorney has replaced the abstract in response to the Examiner's objection with a smaller abstract meeting the size requirements. In addition, the abstract was reworded for clarification.

THE 112 REJECTION

In item 3 of the office action, claim 27 was rejected under 35 U.S.C. 112, second paragraph. Claim 27 was amended in response to this item of the office action as follows: "a variety or sources" was amended to read --a variety of sources--.

In item 4 of the office action, claim 40 was rejected under 35 U.S.C. 112, second paragraph. Claim 40 was amended in response to this item of the office action as follows: "the additional step of" was amended to read --the additional steps of--.

In item 5 of the office action, claim 47 was rejected under 35 U.S.C. 112, second paragraph. Claim 40 was amended in response to this item of the office action as follows: on line 5, the term "represents" was amended to read --represent--.

THE 102(b) REJECTION

In items 9-10 of the office action, claims 1-4, 8, 11, 21-23, 25, 30 and 49 were rejected under 35 U.S.C. 102(b), as being anticipated by Maa. Maa, as currently amended, does not anticipate Applicants' invention for the following reasons:

1. Maa is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
 2. Maa does not disclose the purpose, means or mechanism that this invention discloses.
 3. Maa does not solve the problems that this invention solves.
 4. Maa does not disclose each and every element of this invention.
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1. Maa is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.

There is not anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

Maa is not capable of functioning the same as this invention because Maa has a single function. It is intended to be used as a toy. Its dataflow is from the computer to the user. On the other hand, Applicants' invention is intended to be used as a general-purpose I/O device, such as a keyboard or mouse. In particular, it is intended to be used by any application program within the system. It is designed to have a standard interface which will allow multiple programs to access and control the device. This is substantially different from the single-purpose toy which is taught by the prior art. To more clearly define Applicants' invention over Maa, independent claim 1 has been modified to include limitations which do not appear in Maa. In particular, additional limitations related to the universal adapter, the base unit, and their interaction with movable figures which each may have different ornamental appearances were added. Further, limitations were added to independent claims 1, 21 and 49 which describe the use of a common software interface which allows multiple software applications to access and use the I/O device. Maa has no such function, and therefore, the claims, as currently amended, cannot be anticipated by Maa.

2. **Maa does not disclose the purpose, means or mechanism that this invention discloses.**

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. v. Aluminum Company of America, 120 U.S.P.Q. 362.

The goals or objects of Applicants' invention, without limitation, are to provide a bidirectional multimedia I/O device which will allow any number of applications to communicate with a user with audio and/or motion data exchange. Maa's goal is to provide a toy which uses a single application to entertain via sound and motion, but it is not intended to be used as a general-purpose communication device which can be concurrently accessed by multiple software applications.

Maa cannot meet these objects to the extent that Applicants' invention can, because Maa as a toy controlled by a single software application. It does not provide any means to be used as a general-purpose I/O device. The application describes many functional uses of Applicants' invention, and is not restricted to the single toy application in Maa. Applicants' invention specifically describes the use of software interfaces which provide Applicants' invention the ability to be controlled either individually or concurrently by any software application. Maa provides no such function.

3. Maa does not solve the problems that this invention solves.

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Maa does not provide a shared I/O device which extends motion communications capability to any software application on the system. Applicants' invention allows any software application to communicate with a user via motion.

4. Maa does not disclose each and every element of this invention.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Maa does not disclose a standard software interface which allows applications to communicate via motion data. In addition, Maa does not disclose the use of a standard base unit which can be used to control multiple interchangeable motion figures, which may each have a different ornamental appearance. As noted above, these elements were added to independent claims 1, 21 and 49 to further distinguish them over Maa.

For all the reasons set forth above, Applicants' invention, as now claimed, is not anticipated by Maa.

In item 11 of the office action, claims 13-14 and 16 were rejected under 35 U.S.C. 102(b), as being anticipated by Tong. Applicants' invention, as currently amended, does not anticipate Tong for the following reasons:

Tong is functionally equivalent to Maa. Like Maa, it is a computer controlled toy which provides an entertainment and/or educational function for children. As was the case above, Applicants' invention is a multimedia I/O device which is intended to be used by any number of applications on the system, much like a mouse or keyboard. It uses a standard software interface that allows any application to address the I/O device and control it just as the software application would control any other type of device. Independent claim 13 was further limited by the inclusion of elements related to the common software interface which is designed to allow multiple programs currently access control the I/O device. Tong neither teaches or suggests any such function.

In item 12 of the office action, claims 34-36 were rejected under 35 U.S.C. 102(b), as being anticipated by Liu. Applicants' invention, as currently amended, does not anticipate Tong for the following reasons:

Liu is a computer controlled toy which provides an entertainment and/or educational function for children. Again, Applicants' invention is a multimedia I/O device which is intended to be used by a variety of applications. It has the characteristics of a mouse or keyboard in that it is a general-purpose I/O device. As a toy, Liu is much more limited in its function. The common software interface used by Applicants' invention make the I/O device available to every software application. Independent claim 34 was further limited by the inclusion of elements related to the common software interface which is designed to allow multiple programs currently access control the I/O device. Liu neither teaches or suggests any such function.

Applicant's Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

THE 103 REJECTION

In items 13-14 of the office action, claims 10 and 28 were rejected under 35 U.S.C. 103, as being unpatentable over Maa. Applicant is responding to this basis of rejection as follows:

Applicants' Attorney believes that the invention, as currently claimed, is not obvious in light of Maa for the following reasons.

The Section 103 objection only applies:

. . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicants' invention is not obvious and thereby unpatentable in view of Maa for the following reasons:

1. **The reference cited does not make obvious Applicants' invention as a whole.**

The obviousness inquiry is not whether each element can be found in the prior art, but whether the prior art made obvious the invention as a whole. Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988); Hartness Int'l. Inc. v. Simplimatic Eng. Co., 819 F.2d 1100, 1108, 2 U.S.P.Q. 1826, 1832 (Fed.Cir. 1987); and

ACA Hosp.Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Maa specifically teaches a device which is a toy. Applicants' invention is designed to be a general-purpose I/O device which can be used by any application. Maa does not address the problem of providing motion as a universally accessible function for software applications. Applicants' invention provides a solution for this problem. Further, Maa does not teach or suggest a solution to this problem.

2. The invention in Maa is not designed to accomplish the objects and goals of Applicants' invention, as set forth more fully herein.

A finding of obviousness cannot be made by combining the teachings of the prior art to produce the claimed invention if the prior art does not specifically teach or suggest that the combination be made. Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 U.S.P.Q. 337, (Fed. Cir. 1985), vacated and remanded, 106 S.Ct. 1578, 229 U.S.P.Q. 478 (1986), aff'd in part and rev'd in part, 810 F.2d 1561, 1568, 1 U.S.P.Q. 2d 1593, 1597 (Fed. Cir. 1987), In re Stencil, 828 F.2d 751, 755, 4 U.S.P.Q. 2d 1071, 1073 (Fed. Cir. 1987), citing Interconnect Planning Corp. V. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and In re Corkill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. 1005, 1009-10 (Fed. Cir. 1985).

Maa is clearly designed for use as a toy for children. Applicants' invention is designed to provide motion as a communication means for all software applications. Maa could never be used to solve the problem that Applicants' invention solves, because it provides no standard device interface which applications that access.

Claim 10 was canceled and subject matter was incorporated into independent claim 1. In addition, claim 28 was amended to depend from claim 1. To more clearly define Applicants' invention over Maa, additional limitations were added to claim 1 to recite the common software

interface, as described above. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 15 of the office action, claim 15 was rejected under 35 U.S.C. 103, as being unpatentable over Tong. Applicants' Attorney believes that the invention, as currently claimed, is not obvious in light of Tong for the following reasons:

First, claim 15 depends from newly amended claim 13. If claim 13 is held allowable, then claim 15 will also be allowable. In addition, the example provided by the Examiner regarding remote-controlled cars differs from the situation with Applicants' invention. The base station used by Applicants' invention allows the movable figure to function, and therefore, it cannot be separated from the movable figure during use. A remote-controlled car which may be stored or charged in a base is different from Applicants' invention and that it cannot work while the two components are together. Further, they would normally be together for convenience and not for a particular application during use. In any event, Applicant's Attorney believes that the amendment to independent claim 13 has limitations which are not present in the prior art. Applicant's Attorney respectfully requests that the Examiner reconsider this basis of rejection with a view towards allowance.

In item 16 of the office action, claim 29 was rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Lee. Claim 29 is amended to include further limitations not appearing in Maa. In particular, claim 29 has been amended to include elements related to the attachment means which allow multiple multiple figures to use the same base unit. Applicants' Attorney believes that due to the amendment, this basis of rejection has been overcome.

In item 17 of the office action, claims 5-7 and 24 were rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Liu. Applicants' Attorney believes that based on the

amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 18 of the office action, claims 12 and 26 were rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Yeon. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 19 of the office action, claims 9 and 51 were rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Kikinis. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 20 of the office action, claim 32 was rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Tong. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 21 of the office action, claim 19 was rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of McPhail. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 22 of the office action, claim 33 was rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Sega. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 23 of the office action, claim 18 was rejected under 35 U.S.C. 103, as being unpatentable over Tong in view of Galyean. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 24 of the office action, claims 20 and 31 were rejected under 35 U.S.C. 103, as being unpatentable over Tong in view of Galyean, and further in view of Behrens. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 25 of the office action, claims 37-39 were rejected under 35 U.S.C. 103, as being unpatentable over Liu in view of Kikinis. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 26 of the office action, claims 45 and 48 were rejected under 35 U.S.C. 103, as being unpatentable over Liu in view of Galyean. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 27 of the office action, claim 40 was rejected under 35 U.S.C. 103, as being unpatentable over Liu in view of Kikinis, and further in view of Maa. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 28 of the office action, claims 41-44 and 46 were rejected under 35 U.S.C. 103, as being unpatentable over Liu in view of Kikinis, and further in view of Maa, and further in view

of Tong. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 29 of the office action, claim 47 was rejected under 35 U.S.C. 103, as being unpatentable over Tong in view of Galyean. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 30 of the office action, claims 27 and 50 were rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Kaminsky. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

In item 31 of the office action, claim 17 was rejected under 35 U.S.C. 103, as being unpatentable over Maa in view of Liu, and further in view of Yeon. Applicants' Attorney believes that based on the amendments to the independent claims, this basis of rejection has been overcome, and respectfully requests the Examiner to reconsider the rejection with a view toward allowance.

ADDITIONAL CHANGES

In addition to the foregoing amendments, Applicants' Attorney has amended claims 2, 4-6, and 22-25 to more accurately describe the communication path which uses the base unit to communicate between the movable figure in the computer. Claim 44 was amended to correct a typographical error.

NEW CLAIMS

Serial number: 10/604,387

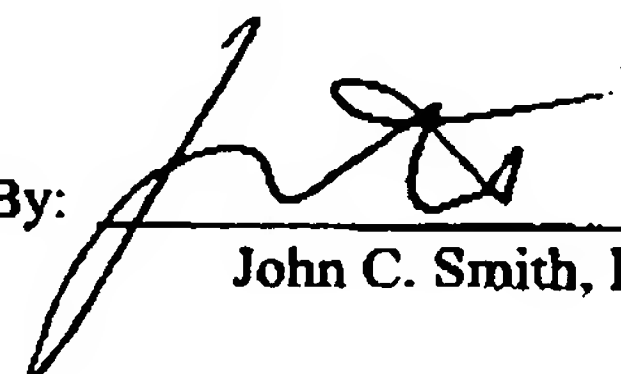
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In addition to the foregoing, Applicants' have added new claims 52-58 to more accurately describe all the features of the invention. The elements of the new claims, such as the processor and associated software are shown in the application and figures as originally filed. No new matter has been added.

CONCLUSION

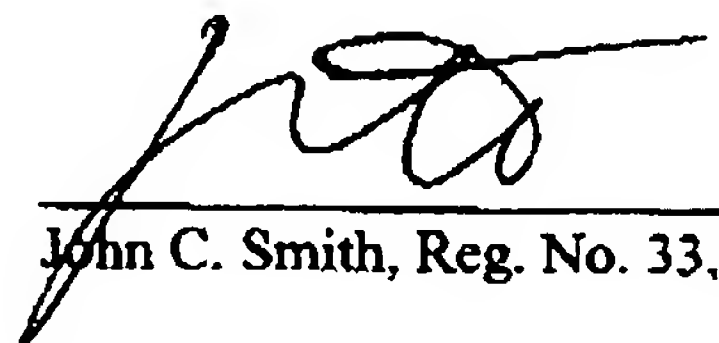
Applicants' Attorney thanks the Examiner for the Examiner's help in prosecuting this invention. In response to the office action, Applicants' Attorney has amended the abstract and claims 1-2, 4-6, 12-13, 21-25, 27, 29, 33-34, 36-37, 39-40, 44, 46-47, 49 and 51. Claims 3, 10-11 and 28 are canceled, and new claims 52-59 have been added. Applicants' Attorney has been careful to avoid the introduction of new matter. In addition, a separate petition and fee for a one month extension of time is attached. Applicants' Attorney believes that all items in the office action dated November 18, 2004 have been addressed, and respectfully requests the Examiner to reconsider the claims, as amended, with a view towards allowance. Applicants' Attorney further invites the Examiner to contact Applicants' Attorney for a telephonic interview at the below listed number if the Examiner believes that prosecution of the application can be furthered by so doing.

Respectfully submitted,

By: 
John C. Smith, Reg. No. 33,284

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on: March 18, 2005
Date of Deposit



John C. Smith, Reg. No. 33,284

March 18, 2005
Signature Date